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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,912	03/26/2004	Junichiro Hosokawa	Q80656	7693

23373 7590 01/29/2007

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
LE, HOA VAN	
ART UNIT	**PAPER NUMBER**
1752	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/809,912	HOSOKAWA ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July to 21 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-23,25-28 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-23,25-28 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date —.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This is in response to Papers filed from 11 July to 21 December 2006.

I. The instant specification on page 5, line 6 as pointed out by applicants that the claimed compound has "its coloring property". There is no teaching or suggestion that the claimed compound has no coloring property as urged. Therefore, the arguments are not found to be convincing. There is no objection and rejection over the issue of new matter as urged. It is conventional in the art to use more than one color coupler agent. The instant claims are read two or more color coupler agents with (1) "a coloring coupler" #1 and (2) a color coupler "compound" "C" "other than the coloring coupler" #1.

II. The amendment filed 19 December 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The language "main" as newly added finds no support at page 64, lines 21-23 in the specification as urged. Evidence can be seen on page 51, line 1 that compound (C) can be used in a great portion of up to "1000

mg/m^2" while other coupler, ExY-3, in Example 1 can be used as low as 0.007 mg/m^2 on page 111, line 24 as originally filed. For the issue of new matter, please see Tronazo v. Biomet Inc., 4 USPQ2d 1403. The record shows that these kinds of things are not new or the first time during the prosecution of this application. Evidence can be seen in the issue in paragraph "I" above. Therefore, one should be carefully look in to the issue of new matter during prosecution of the application. An allowed claim or patent would have no value when someone shows that a claim and/or an amendment has a new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

III. Claims 21-23, 25-28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language "main" as newly added finds no support at page 64, lines 21-23 in the specification as urged. Evidence can be seen on page 51, line 1 that compound

(C) can be used in a great portion of up to "1000 mg/m^2" while other coupler, ExY-3, in Example 1 can be used as low as 0.007 mg/m^2 on page 111, line 24 as originally filed. For the issue of new matter, please see Tronazo v. Biomet Inc., 4 USPQ2d 1403. The record shows that these kinds of things are not new or the first time during the prosecution of this application.

Evidence can be seen in the issue in paragraph "I" above. Therefore, one should be carefully look in to the issue of new matter during prosecution of the application. An allowed claim or patent would have no value when someone shows that a claim and/or an amendment has a new matter.

IV. Prior art submissions filed on 15 September and 23 August 2006 have been considered to the extent of the English language as provided only.

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-23, 25, 27-28 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsuoka et al (5,384,236).

Matsuoka et al disclose and teach a method for using an amount of from 0.001 mol per mol of silver of a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than that in the general formula ©. Please see the whole disclosure of the applied reference, especially at col.2:6 and 16 to 8:2, compounds (1) to (57), 32:54-56, 56:39-42, Examples, Table B on cols.63 and 64, 65:50-60 and 68:9-11. The language "main", "5-100 mg/m^2", "change a film...to 3.0" as that in claim 22, pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in the original claim 28 or the like is a functional property of a material or a measurement of a property of a material and considered inherent. For a patentability of a functional property of a material or a measurement of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the

contrary since arguments alone are not a factual evidence in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. Since Matsuoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Matsuoka et al.

In alternative, the remote teachings and suggestions and/or obviously about the same result as that of the functional property is reasonable found to be rendered prima-facie obvious by Matsuoka et al.

Applicant's arguments filed 19 and 21 December 2006 have been fully considered but they are not persuasive.

Applicants urge that Matsuoka et al do not disclose, teach or suggest the use of a small amount of a compound being read on the claimed compound©. Please see col. 32:54-57, an amount from 0.001 mol per mol of silver can be used.

VI. Claims 21-23, 25, 27-28 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagaoka et al (5,460,929).

Nagaoka et al disclose and teach a method for using an amount of from 0.000 004 (with 4x16-6 being obviously typographical error) mol per mol of silver of a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than that in the general formula ©.Please see the whole disclosure of the applied reference, especially at col.1:8-9, 9:14 to 14:67, compounds (1) to (48), 39:3-5, 41:1-3, Examples, "Emulsion D" on col.176:26 and on col.179 with respect to the top Table on left column of "Emulsion" from C then to D and on col.182 with Table 84 with "6^{th}" layer. The language "main", "5-100 mg/m^2", "change a film...to 3.0" as that in claim 22, pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in the original claim 28 or the like is a functional property of a material or a measurement of a property of a material and considered inherent. For a patentability of a functional property of a material or a measurement of a property of a material embodiment, it is allowed by law to

request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. Since Matsuoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Nagaoka et al.

In alternative, the remote teachings and suggestions and/or obviously about the same result as that of the functional property is reasonable found to be rendered prima-facie obvious by Nagaoka et al.

Applicant's arguments filed 19 and 21 December 2006 have been fully considered but they are not persuasive.

Applicants urge that Nagaoka et al do not disclose, teach or suggest the use of a small amount of a compound being read on the claimed compound©. Please see col. 41:1-3, an amount from 0.000 004 (with 4x16-6 being obviously typographical error) mol per mol of silver can be used.

VII Claims 21-23, 25, 27-28 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mihayashi et al (5,543,282).

Mihayashi et al disclose and teach a method for using an amount of from 0.001 mol per mol of silver of a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than that in the general formula ©. Please see the whole disclosure of the applied reference, especially at col.1:13:6, 3:25 to 10:22, compounds (1) to (52), 37:2-6, 38:51-52, Examples, col.68 with respect Emulsion 5 on Table 1 and Samples 116 and 117 on Table 3 at cols. 87 and 88, 89:34, Table 5 with "Emulsion" "7-1" and "8-1" on cols. 95 and 96, Table 6 with "Sample" "303", "304", "307", "308", "311" and 312" on cols. 97 and 98. The language "main", "5-100 mg/m^2", "change a film...to 3.0" as that in claim 22, pKa value...to 8.4" as that in claim 23 and "reactivity...to 1.0" as that in the original claim 28 or the like is a functional property of a material or a measurement of a property of a material and considered inherent. For a patentability of a functional property of a material or a

measurement of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. Since Matsuoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Matsuoka et al.

In alternative, the remote teachings and suggestions and/or obviously about the same result as that of the functional property is reasonable found to be rendered prima-facie obvious by Matsuoka et al.

Applicant's arguments filed 19 and 21 December 2006 have been fully considered but they are not persuasive.

Applicants urge that Matsuoka et al do not disclose, teach or suggest the use of a small amount of a compound being read on the claimed compound©. Please see col. 37:2-6, an amount from 0.001 mol per mol of silver can be used.

VIII. Applicants also state on and for the record that there is no reference on the record being read on claim 26. Accordingly, the requests and rejection in the previous Office action mailed 20 June 2006 are withdawn.

IX. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
23 January 2007

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le